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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/505,466	03/14/2005	Stephen Foster	DEHNF-001US	8885
7663	7590	04/06/2006	EXAMINER	
STETINA BRUNDA GARRED & BRUCKER			MITCHELL, TEENA KAY	
75 ENTERPRISE, SUITE 250			ART UNIT	
ALISO VIEJO, CA 92656			PAPER NUMBER	
			3743	

DATE MAILED: 04/06/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/505,466

Applicant(s)

FOSTER ET AL.

Examiner

Teena Mitchell

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10/14/05; 1/17/06.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 18-35 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 and 18-35 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 20 August 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>10/14/05</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Drawings

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the elongate tube in fluid communication with the exhaust channel must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 28, 34, and 35 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The newly added claims have limitations which lack support from the originally filed specification, the limitations are: "...exhaust channels are substantially linear and intersect one another at an angle of at least ninety degrees..." and "...the inlet channel is approximately one-fourth the cross-sectional area of at least one of the breathing and exhaust channels..." and in claim 35, "...wherein the axis of the gas inlet channel is directed towards an elbow disposed at an inner edge of junction between the breathing and exhaust channels.." such added limitations constitute new matter.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

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A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 18-21, 23-25, 27, 29, 32, and 33 are rejected under 35 U.S.C. 102(b) as being anticipated by Bird et.al. (3,630,196).

With respect to claim 1, Bird discloses a breathing device (11) comprising in fluid communication, a breathing channel 23) and an exhaust channel (at 53) extending from a junction there between; and a gas inlet channel (42, 81, 82) arranged so as in use to introduce gas into said breathing channel such that in use a positive pressure may be maintained in the breathing channel, wherein an axis of the said gas inlet channel is laterally offset from an axis of the breathing channel at the point at which the gas inlet channel introduces the gas into the breathing channel (Figs. 4, 5).

With respect to claim 18, Bird discloses wherein the axis of the gas inlet channel is laterally offset from an axis of the breathing channel at a narrowest part of the breathing channel (Figs. 4, 5).

With respect to claim 19, Bird discloses wherein the breathing channel is of a substantially constant cross-sectional area (Figs. 4, 5).

With respect to claim 20, Bird discloses wherein the breathing channel has a substantially circular cross-section (Figs. 4, 5).

With respect to claim 21, Bird discloses wherein the gas inlet channel opens into the breathing channel (Figs. 4, 5).

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With respect to claim 23, Bird discloses wherein the gas inlet channel is laterally offset from the axis of the breathing channel in a direction toward the exhaust channel (Figs. 4, 5).

With respect to claim 24, Bird discloses wherein the gas inlet channels is inclined relative to the breathing channel axis (Figs. 4, 5).

With respect to claim 25, Bird discloses at least two gas inlet channels at different lateral offsets and inclinations (at 29, 42).

With respect to claim 27, Bird discloses wherein the gas inlet channel (at 29, 42) is narrower than at least one of the exhaust and breathing channel (Figs. 4, 5).

With respect to claim 29, Bird discloses wherein the breathing device is adapted to be attached directly to a face of a patient (via 24).

With respect to claim 32, Bird discloses wherein the gas inlet channel is arranged to provide a degree of gas bypass such that increased pressure is provided during inhalation (Figs. 4, 5).

With respect to claim 33, Bird discloses wherein the gas inlet channel has a cross-sectional area that is smaller than a cross-sectional area of at least one of the breathing and exhaust channels (Figs. 4, 5).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been

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obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 22, 26, 30, and 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bird et.al. (5,193,532).

The difference between Bird and claim 22 is the location of the gas inlet open into the junction between the breathing channel and the exhaust channel on an outer side of the junction. It would have been an obvious matter of design consideration to

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one of ordinary skill in the art to have the location of the gas inlet open into the junction between the breathing channel and the exhaust channel on an outer side of the junction since it has been held that rearranging parts of an invention involves only routine skill in the art.

With respect to claim 26, Bird does not disclose that the gas inlet is moveable. It would have been obvious to one of ordinary skill in the art at the time the invention was made to use a bendable material to allow movement of the gas inlet, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of design consideration also having a moveable gas inlet would allow the user more mobility.

With respect to claim 30, Bird does not disclose the use of a mask. However, it is well known in the art that nasal prongs can be substituted for mask and therefore the use of a mask is deemed to be a design consideration, which fails to patentably distinguish over Bird.

With respect to claim 31, Bird does not disclose a tube in fluid communication with the exhaust channel. It would have been an obvious matter of design consideration to one of ordinary skill in the art at the time the invention was made to have a tube off the exhaust channel to allow the exhaust air to be collected if anesthetic agent is being delivered to be scavenged, and/or to allow the air to be diverted away from the face of a user.

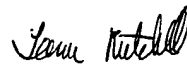
Response to Arguments

Applicant's arguments with respect to claim 1 have been considered but are moot in view of the new ground(s) of rejection.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Teena Mitchell whose telephone number is (571) 272-4798. The examiner can normally be reached on Monday-Friday however the examiner is on a flexible schedule.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Henry Bennett can be reached on (571) 272-4791. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Teena Mitchell
Primary Examiner
Art Unit 3743
March 31, 2006


TKM